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FRANK C. NICHOLAS (33,983)
Name of Appellant, assignee or registered representative
/FRANK C. NICHOLAS/
Signature
January 8, 2007
Date of Signature

PATENT
Case No. AUS920010138US1
(9000/25)

**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is Appellants second appeal brief.

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1. REAL PARTY IN INTEREST

The real party in interest is assignee INTERNATIONAL BUSINESS MACHINES CORPORATION, a corporation organized and existing under the laws of the State of New York, USA and located at New Orchard Road, Armonk, New York 10504, USA

2. RELATED APPEALS AND INTERFERENCES

Appellant and the undersigned attorneys are not aware of any appeals or any interferences which will directly affect or be directly affected by or having a bearing on the Board's decision in the pending appeal.

3. STATUS OF CLAIMS

Claims 1-18 are currently pending in the application and stand finally rejected under 35 U.S.C. §112, 35 U.S.C. §101, and 35 U.S.C. §103(a) as unpatentable. All claims are on appeal. See, the Appendix.

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4. STATUS OF AMENDMENTS

All amendments have been entered in the application.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 1:

Independent claim 1 recites a method for generating metadata objects. The method includes displaying S52 a spreadsheet 60 including metadata information MDI therein and providing S54 a command to trigger a conversion of the spreadsheet 60 into a comma separated value file. See, FIGS 3, 4, and 1, and pages 4-9 of the specification.

Independent claim 4:

Independent claim 4 recites a method for generating metadata objects. The method includes displaying S52 a spreadsheet 60 including metadata information MDI and one or more metadata directives MDD therein and providing S54 a command to trigger a conversion of the spreadsheet 60 into a comma separated value file. See, FIGS 3, 4, and 1, and pages 4-9 of the specification.

Independent claim 7:

Independent claim 7 recites a computer for generating metadata objects. The computer includes means for displaying S52 a spreadsheet 60 including metadata information MDI therein; and means for providing a command to trigger a conversion of the spreadsheet 60 into a comma separated value file. See, FIGS 3, 4, and 1, and pages 4-9 of the specification.

Independent claim 10:

Independent claim 10 recites a computer for generating metadata objects. The computer includes means for displaying a spreadsheet 60 including metadata information MDI and one or more metadata directives MDD therein and means for providing S54 a command to trigger a conversion of the spreadsheet 60 into a comma separated value file. See, FIGS 3, 4, and 1, and pages 4-9 of the specification.

Independent claim 13:

Independent claim 13 recites a computer program product in a computer readable medium for generating metadata objects. The computer program product includes computer readable code for displaying S52 a spreadsheet 60 including metadata information MDI therein and computer readable code for providing S54 a command to trigger a conversion of the spreadsheet 60 into a comma separated value file. See, FIGS 3, 4, and 1, and pages 4-9 of the specification.

Independent claim 16

Independent claim 16 recites a computer program product in a computer readable medium for generating metadata objects. The computer program product includes computer readable code for displaying S52 a spreadsheet 60 including metadata information MDI and one or more metadata directives MDD therein and computer readable code for providing S54 a command to trigger a conversion of the spreadsheet 60 into a comma separated value file. See, FIGS 3, 4, and 1, and pages 4-9 of the specification.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-18 were rejected under 35 U.S.C. §112 as failing to comply with the enablement requirement.

Claims 1, 4, 7, 10, 13, and 16 were rejected under 35 U.S.C. §101 as nonstatutory.

Claims 1-18 were rejected under 35 U.S.C. §103(a) as unpatentable over Egilsson, United States Patent 6,286,017 (“Egilsson”) in view of a publication to Chester.

7. **ARGUMENTS**

The §112 rejection

The rejection of claims 1-18 as failing to comply with the enablement requirement is traversed. The Examiner's rejection is unsupported and contrary to clear law. An Appellant's specification must enable a person skilled in the art to make and use the claimed invention without undue experimentation. The fact that experimentation is complex does not make it undue. For computer related inventions, the specification need only enable a skilled artisan to configure the computer to possess the requisite functionality without the exercise of undue experimentation. See, MPEP §2106(B)(2). The Examiner's allegation that he can "find no evidence in the specification of what the difference between metadata information and metadata objects and the defined difference is essential to enable the invention" is entirely irrelevant.

When basing a rejection on the failure of the Appellant's disclosure to meet the enablement provisions of the first paragraph of §112, the examiner must establish on the record that he or she has a reasonable basis for questioning the adequacy of the disclosure to enable a person of ordinary skill in the art to make and use the claimed invention without resorting to *undue experimentation*. See *In re Brown*, 477 F.2d 946, 177 USPQ 691 (CCPA 1973); *In re Ghiron*, 442 F.2d 985, 169 USPQ 723 (CCPA 1971). See, MPEP 2106.01. The Examiner has failed to do so.

Additionally, the Examiner's allegation that there is no definable difference between metadata information and metadata objects is not relevant, even if true, to an enablement rejection. The Examiner's allegation that the claim contains subject matter not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention is unsupported by evidence.

Appellant pointed out each of these flaws to the Examiner, and requested the Examiner clarify the position – however, the Examiner failed to do so, and instead merely reiterated the faulty rejections. The Examiner failed to support his argument with any *evidence* defining the level of skill possessed by one of ordinary skill in the art and the level of experimentation typically engaged in by those of skill in the art. Appellants maintain that those of skill in the art are familiar with the concepts of metadata and possess sufficient skill to make and use the claimed invention without undue experimentation.

With respect to the Examiner's alleged confusion relating to differences between data and data objects, Appellants respectfully point to page 1, lines 7-13, wherein Appellants note that metadata objects may refer to instances of "classes persisted to a file, relational or object-oriented database or simply rows in tables in a relational database." In other words, a "data object" is a file containing data. Additionally, the difference in meaning is further made clear in the discussion of page 1, lines 16-23.

Withdrawal of the §112 rejections is requested.

The §101 rejection

The §101 rejections are traversed as contrary to law. The Examiner's allegation that "all of these claims fail to produce any sort of concrete and tangible result" is legally insufficient, even if it were true, to support a utility rejection. The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. See, e.g. MPEP §2106.

In particular, when functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. See, MPEP §2106.01, and *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)(discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer

readable medium that increases computer efficiency) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). A claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Additionally, claims 7, 10, 13, and 16 recite "a computer" or "a computer program product" which are, in fact, concrete and tangible objects.

Withdrawal of the §101 rejection is requested.

The §103 rejection

The §103(a) rejections of claims 1-18 as unpatentable over Egilsson in view of Chester are traversed. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. *See* MPEP 2143. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). *See* MPEP 2143.03. Appellants respectfully assert that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

The mere fact that Egilsson can be modified in view of Chester to obtain the claimed invention as recited in claims 1-18 does not render the resultant modification obvious unless the prior art also suggests the desirability of the combination. *See*, *In re Mills*, 916 F.2d 680,

16 USPQ2d 1430 (Fed. Cir. 1990) (claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

The basis for the Examiner's allegation is simply that "it would have allowed easy import and export of files in a standard format". However, the Examiner cannot conclusively assert that use of the Chester "conversion of spreadsheet files into CSV files" would assist in the creation of an "application building and managing environment in which users of computer systems, including ones with minimal programming knowledge, create and share powerful software applications, as Egilsson teaches is desirable. See, Egilsson, col. 1, lines 12-16. This is particularly true in light of the fact that Egilsson does not denounce its graphical environment for managing and developing applications as anything less than an ideal solution to the problems, and in light of the fact that Chester does not pronounce its "conversion of spreadsheet files into CSV files" as the ultimate method of displaying metadata.

Here, the Examiner has apparently simply added the proverbial 1+1 to allege obviousness, but this is antithetical to the mandates of the law. Obviousness requires more than a simple addition, and requires that there be motivation to combine the references in the fashion that the Examiner *ex post facto* suggests.

The Examiner's allegation (p. 9 of the August 9, 2006 action) that Egilsson teaches the use of spreadsheets is not relevant, even if true. Egilsson does not teach that it would be desirable to provide a method of importing/exporting data in CSV without user interaction –

at most, Egilsson teaches that a spreadsheet user to create general software without abandoning spreadsheet methodology. The Examiners errs in failing to consider the chasm between using a spreadsheet to create general software and importing data in CSV without user interaction. Egilsson does not make any teachings that would direct those of skill in the art to seek out the teachings of Chester in order to assist in the creation of general software using a spreadsheet, and Egilsson does not make any teachings that would suggest the desirability of the claimed invention.

Therefore, the Examiner cannot support this §103(a) rejection over Egilsson in view of Chester, and Appellants request withdrawal of all rejections.

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CONCLUSION

The Appellants respectfully submit that claims 1-18 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

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Respectfully submitted,
RICHARD D. HOFFMAN, *et al.*

CARDINAL LAW GROUP
Suite 2000
1603 Orrington Avenue
Evanston, Illinois 60201
Phone: (847) 905-7111
Fax: (847) 905-7113

/FRANK C. NICHOLAS/

Frank C. Nicholas
Registration No. 33,983
Attorney for Appellants

9. CLAIMS APPENDIX

1. A method for generating metadata objects, said method comprising:
displaying a spreadsheet including metadata information therein; and
providing a command to trigger a conversion of the spreadsheet into a comma separated value file.
2. The method of claim 1, further comprising:
converting the spreadsheet into the comma separated value file in response to an activation of the command; and
parsing the comma separated value file to thereby generate the metadata objects from the metadata information.
3. The method of claim 1, further comprising:
inputting the metadata information into the spreadsheet in response to a reception of the metadata information.
4. A method for generating metadata objects, said method comprising:
displaying a spreadsheet including metadata information and one or more metadata directives therein; and
providing a command to trigger a conversion of the spreadsheet into a comma separated value file.

5. The method of claim 4, further comprising:
 - converting the spreadsheet into the comma separated value file in response to an activation of the command; and
 - parsing the comma separated value file in accordance with the one or more metadata directives to thereby generate the metadata objects from the metadata information.
6. The method of claim 4, further comprising:
 - inputting the metadata information into the spreadsheet in response to a reception of the metadata information; and
 - inputting the one or more metadata directives into the spreadsheet in response to a reception of the one or more metadata directives.
7. A computer for generating metadata objects, said computer comprising:
 - means for displaying a spreadsheet including metadata information therein; and
 - means for providing a command to trigger a conversion of the spreadsheet into a comma separated value file.
8. The computer of claim 7, further comprising:
 - means for converting the spreadsheet into the comma separated value file in response to an activation of the command; and
 - means for parsing the comma separated value file to thereby generate the metadata objects from the metadata information.
9. The computer of claim 7, further comprising:
 - means for inputting the metadata information into the spreadsheet in response to a reception of the metadata information.

10. A computer for generating metadata objects, said computer comprising:
means for displaying a spreadsheet including metadata information and one or more metadata directives therein; and
means for providing a command to trigger a conversion of the spreadsheet into a comma separated value file.
11. The computer of claim 10, further comprising:
means for converting the spreadsheet into the comma separated value file in response to an activation of the command; and
means for parsing the comma separated value file in accordance with the one or more metadata directives to thereby generate the metadata objects from the metadata information.
12. The computer of claim 10, further comprising:
means for inputting the metadata information into the spreadsheet in response to a reception of the metadata information; and
means for inputting the one or more metadata directives into the spreadsheet in response to a reception of the one or more metadata directives.
13. A computer program product in a computer readable medium for generating metadata objects, said computer program product comprising:
computer readable code for displaying a spreadsheet including metadata information therein; and
computer readable code for providing a command to trigger a conversion of the spreadsheet into a comma separated value file.

14. The computer program product of claim 13, further comprising:
computer readable code for converting the spreadsheet into the comma separated value file in response to an activation of the command; and
computer readable code for parsing the comma separated value file to thereby generate the metadata objects from the metadata information.
15. The computer program product of claim 13, further comprising:
computer readable code for inputting the metadata information into the spreadsheet in response to a reception of the metadata information.
16. A computer program product in a computer readable medium for generating metadata objects, said computer program product comprising:
computer readable code for displaying a spreadsheet including metadata information and one or more metadata directives therein; and
computer readable code for providing a command to trigger a conversion of the spreadsheet into a comma separated value file.
17. The computer program product of claim 16, further comprising:
computer readable code for converting the spreadsheet into the comma separated value file in response to an activation of the command; and
computer readable code for parsing the comma separated value file in accordance with the one or more metadata directives to thereby generate the metadata objects from the metadata information.

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18. The computer program product of claim 16, further comprising:
 - computer readable code for inputting the metadata information into the spreadsheet in response to a reception of the metadata information; and
 - computer readable code for inputting the one or more metadata directives into the spreadsheet in response to a reception of the one or more metadata directives.

10 EVIDENCE APPENDIX

Appellants entered no evidence pursuant to §1.130, 1.131 or 1.132, and the Examiner entered no evidence that was relied upon by Appellants.

11. RELATED PROCEEDINGS APPENDIX

There are no copies of related decisions or proceedings.